

REMARKS

In response to the Office Action dated December 1, 2008, the applicant amended claim 1 and added new claims 33-34. Claims 1-8, 14, 16-24 and 32-34 are presented for examination, with claims 3-5, 7, and 17 previously being withdrawn from consideration. The claim amendment and new claims are supported in the specification as filed, including paragraphs [0043], [0055], and [0058] in corresponding published patent application US2004/0091543. No new matter is added.

The Examiner rejected claims 1, 2, 6, 8, 14, 16, and 18-24 under 35 U.S.C. §102(e) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent 7,131,997 ("Bourne"). As amended, claims 1, 2, 6, 8, 14, 16, and 18-24 cover a first collection of embolic particles having a first shape and a second collection of embolic particles having a second shape different than the first shape, wherein the first shape and the second shape are interlocking shapes. Bourne does not explicitly or inherently disclose a composition covered by claims 1, 2, 6, 8, 14, 16, and 18-24. Instead, Bourne discloses particles having "a substantially uniform spherical shape and size" (*See, e.g.*, col. 4, lines 13-14; col. 6, lines 30-31; and col. 9, lines 20-21). Thus, one skilled in the art would understand Bourne to disclose a composition of particles having a single, spherical shape, not a first collection of embolic particles having a first shape and a second collection of embolic particles having a second shape different than the first shape, wherein the first shape and the second shape are interlocking shapes. Nor has the Examiner pointed to any disclosure of the compositions of claims 1, 2, 6, 8, 14, 16, and 18-24 in Bourne. Instead, the Examiner states that "[t]he applied reference teaches the claimed embolic composition," followed by a series of citations to over 200 lines of text in Bourne as allegedly disclosing certain claimed compositions (Office Action at page 2).¹ However, the Examiner has

¹ Specifically, the Examiner cites the following portions of Bourne: col. 1, lines 45-67 (disclosing methods of treating tissue with "substantially spherical polymer particles"); col. 2, lines 1-25 (disclosing methods of treating particular medical indications with "substantially spherical particles" that can have pores); col. 3, lines 18-28 (disclosing gelling compounds, gelling agents and base polymers); col. 6, lines 16-58 (disclosing particles with pores and "a substantially uniform spherical shape and size"); col. 7, lines 9-23 (disclosing particles with a variance less than about 20% with respect to a mean particle diameter); col. 8, lines 33-67 (disclosing base polymers and gelling precursors for making particles); col. 11, lines 43-46 (citing particles in another patent application); col. 13,

not provided a reasoned statement, or any factual support, describing how these cited passages from Bourne, or any part of Bourne, explicitly or inherently disclose the compositions covered by claims 1, 2, 6, 8, 14, 16, and 18-24. Furthermore, Bourne does not inherently disclose the claimed compositions. To establish that a reference inherently discloses certain subject matter, the Examiner must prove that the features are "necessarily present [in the prior art reference] and that it would be so recognized by persons of ordinary skill." (*Electro Sys. S.A. v. Cooper Life Sciences*, 32 USPQ2d 1017, 1020 (Fed. Cir. 1994) Here, the Examiner has not satisfied the requisite legal standard. Nor would it have been obvious to one skilled in the art to make the compositions covered by claims 1, 2, 6, 8, 14, 16, and 18-24 based on Bourne. In addition, the Examiner provides no factual support for one skilled in the art to modify the disclosure of Bourne to provide a composition including a first collection of embolic particles having a first shape and a second collection of embolic particles having a second shape different than the first shape, where the first shape and the second shape are interlocking shapes (*See* MPEP 2142). Applicant requests reconsideration and withdrawal of the rejection based on Bourne.

Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: February 10, 2009

/Nicholas M. Boivin/

Nicholas M. Boivin

Reg. No. 45,650

Fish & Richardson P.C.

225 Franklin Street

Boston, MA 02110

Telephone: (617) 542-5070

Facsimile: (877) 769-7945

22085495.doc

lines 44-60 (disclosing hydrogel compositions); and col. 14, lines 1-67 (disclosing contrast agents, radiopaque materials, therapeutic agents and other additives). None of these cited portions of Bourne, or any other portion of Bourne, explicitly or inherently disclose a first collection of embolic particles having a first shape and a second collection of embolic particles having a second shape different than the first shape.